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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/728,693 | 12/05/2003 | Stephen H. Albertson | TRACKER.1C1DV1 | 9989 |
| 20995 | 7590 | 12/15/2004 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | MITCHELL, KATHERINE W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,693

Applicant(s)

ALBERTSON ET AL

Examiner

Katherine W Mitchell

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,13,44 -89 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,45-48 and 50-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,9,13,44 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Terminal Disclaimer filed 6/14/04 has been approved and entered.

Election/Restrictions

2. Applicant's election without traverse of 1, 5-7, 9,13, 44, and 49 in the reply filed on Sept 21,2004 is acknowledged. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Examiner notes that claim 8 was cancelled 6/14/2004 and is thus not included in the elected claims.

4. Claims 2-4, 45-48, 50-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/21/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. In claim 9, the claimed invention is directed to non-statutory subject matter.

Applicant is positively claiming a building inspector, and no part of a claim can require

Art Unit: 3677

the inclusion of a person. Therefore, Claim 9 is being examined as though the inspector were not positively recited – i.e., –providing a color key capable of being read by a building inspector... –.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5-7, 9,13, 44, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Schwartz USP 5181439.

Re claims 1 and 13 and 44: Dickson teaches a nail having a shaft and an exposed portion attached to the first end of the shaft and an identifying indicia, corresponding to at least one fastener physical property (length or gauge, Dickson col 2 lines 7-37), on the exposed portion easily recognizable by a person of normal vision. However, Dickson is not clear that the identifier is a color that is recognizable by a person of normal vision from a distance of 18, and thus 10, feet when the shaft is inserted into a surface. Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Col 3 line 17 emphasizes that with this marking, a user can tell "at a glance" the indicated property. Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at at least 10 and/or 18 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 18 feet when

Art Unit: 3677

the shaft is inserted into a surface since it meets the same physical structure. The method of making the fastener is obvious in the fastener itself, and the step of applying the coloring is in Schwartz col 3 lines 24-38 and correlating the color to predetermined physical properties is taught by Dickson in col 2 lines 35-48. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to modify Dickson as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification "at a glance". One would have been motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in col 1 lines 30-62, with col 3 lines 53-col 4 line 3 emphasize that the coloration be "readily seen" when the fastener is in place. Further, fasteners that can be easily matched with a corresponding component, such as a tool or substrate, would have been obtained, which would minimize construction errors and time.

Re claim 5: Dickson teaches a nail having a shaft and an exposed portion attached to the first end of the shaft and an identifying indicia, corresponding to at least one fastener physical property (length or gauge, Dickson col 2 lines 7-37), on the exposed portion easily recognizable by a person of normal vision. However, Dickson is not clear that the identifier is a color that is recognizable by a person of normal vision from a distance of 18 feet when the shaft is inserted into a surface. Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Col 3 line 17 emphasizes that with this marking, a user can tell

Art Unit: 3677

"at a glance" the indicated property. Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at 18 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 18 feet when the shaft is inserted into a surface since it meets the same physical structure. The method of use is obvious in the fastener and further taught in col 3 lines 12-38 of Schwartz.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to modify Dickson as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification "at a glance". One would have been motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in col 1 lines 30-62, with col 3 lines 53-col 4 line 3 emphasize that the coloration be "readily seen" when the fastener is in place. Further, fasteners that can be easily matched with a corresponding component, such as a tool or substrate, would have been obtained, which would minimize construction errors and time thus ensuring that proper fasteners for a specific application have indeed been used.

Re claims 6-7: Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Col 3 line 17 emphasizes that with this marking, a user can tell "at a glance" the indicated property. Also, examiner notes that since the colored top is the property allowing applicant's

Art Unit: 3677

fastener to be recognizable at 18 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 18 feet {and thus 15 feet} when the shaft is inserted into a surface since it meets the same physical structure.

Re claim 9: Re claim 5: Dickson teaches a nail having a shaft and an exposed portion attached to the first end of the shaft and an identifying indicia, corresponding to at least one fastener physical property (length or gauge, Dickson col 2 lines 7-37), on the exposed portion easily recognizable by a person of normal vision. However, Dickson is not clear that the identifier is a color that is recognizable by a person of normal vision from a distance of 18 feet when the shaft is inserted into a surface. Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Col 3 line 17 emphasizes that with this marking, a user can tell "at a glance" the indicated property. Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at 10 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 10 feet when the shaft is inserted into a surface since it meets the same physical structure. Selecting a plurality of colors where each color connotes one or more fastener properties is taught in Schwartz col 2 lines 35-48. The method of use is obvious in the fastener and further taught in col 3 lines 12-38 of Schwartz. While applicant cannot claim a building inspector, examiner notes that Dickson teaches in col 1 lines 60-67 that graphic indicia on the head of a fastener allow building inspectors to tell quickly if a fastener meets the building code requirements by just looking at the fastener head, thus inevitably a key indicating the color/property correlation has been

Art Unit: 3677

provided, and Schwartz specifically teaches the color/property correlation for workers to use in col 2 lines 35-48.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to modify Dickson as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification "at a glance". One would have been motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in col 1 lines 30-62, with col 3 lines 53-col 4 line 3 emphasize that the coloration be "readily seen" when the fastener is in place, and Dickson emphasizes that with the inevitable color/property correlation key a building inspector can verify proper usage. Further, fasteners that can be easily matched with a corresponding component, such as a tool or substrate, would have been obtained, which would minimize construction errors and time, thus ensuring that proper fasteners for a specific application have indeed been used.

Re claim 49: As discussed above under claim 1, Dickson teaches all the elements except that the fastener is a screw. Schwartz teaches that the fastener can be a screw in col 1 line 63, and col 3 lines 53-57 teach that the screw heads have the colored indicators. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to further modify Dickson as taught by Schwartz to include having color-coded properties on screw heads, to ensure that a broad range of fasteners can be

Art Unit: 3677

properly identified without close inspection, to save time and minimize confusing similar-looking screws or nails when trying to select a specific-sized screw or nail.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Response to Arguments

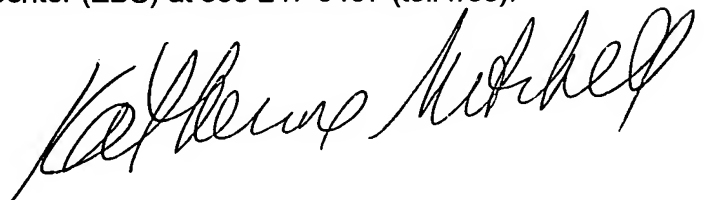
10. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwm
12/2/2004

A handwritten signature in black ink, appearing to read "Katherine W Mitchell", is written over the bottom right portion of the text area.